



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,673	05/03/2006	Christophe Chassain	0579-1099	4123
<div>465 7590 03/18/2010</div> <div>YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314</div>				
EXAMINER				
BOOTH, MICHAEL JOHN				
ART UNIT		PAPER NUMBER		
3774				
NOTIFICATION DATE		DELIVERY MODE		
03/18/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary

Application No.

10/541,673

Applicant(s)

CHASSAIN, CHRISTOPHE

Examiner

MICHAEL J. BOOTH

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/225)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 12/28/2009 have been fully considered but they are not persuasive.

Examiner carefully reviewed Applicant's arguments. Applicant argues, *in summary*, that Nagai fails to anticipate or render obvious the following: 1) disclosure of at least one flexible material junction between two segments; 2) disclosure of sharp edges; 3) optimizing of sizes; and 4) the method of chemically modifying a segment to make it rigid. Examiner *respectfully* disagrees. Nagai clearly anticipates having "at least one flexible material junction between two segments" as required by claim 27. Although this can be seen in several figures of Nagai, the Examiner will focus, *arguendo*, on figures 31 and 32. Figure 31 shows the capsular tension ring, and figure 32 shows an enlarged portion of the ring where the flexible material junction is located. As the figure discloses, the junction receives a portion of the connecting junction, and due to the decrease in thickness of the material, it is more flexible in comparison to its connecting counterparts. Furthermore, it must be flexible in order to receive the edges. As seen, the receiving (or female portion) must flex or expand in order to receive the male portion, due to its size, as clearly indicated in figure 32. Nagai further clearly shows what is identified as "sharp edges", whereby several sharp edges are present in figure 32. With regards to optimizing sizes, it is well known in the art and it has been held that optimizing sizes is well within the technical skill in the art, where it may be desirable, and establishes a *prima facie* case of obviousness. See case law to *In re*

Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP 2144.05. Nagai further discloses chemically modifying segments thus making them more rigid. Nagai discloses expressly that a “mixture” of materials may be used, whereby one combination disclosed is an elastomer and PMMA, whereby the mixture provides for chemically modifying the elastomer to make the combination rigid. Several other combinations are present as well that read on the limitations of the claims.

Examiner has given the claims its’ broadest reasonable interpretation, and maintains that the claims are broad as written and read upon the prior art of record. Although Applicant recites that “dependent claims recite additional patentable features”, Applicant fails to address these specifically for Examiner to comment.

While Examiner acknowledges that Applicant’s inventive concept is distinct from Nagai, Examiner does not see such distinctions in the claim language, as currently written, and thus the claims fail to clearly distinguish over the prior art of record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagai US 2001/0004708.

With respect to the claims, see figures by Nagai, specifically to figure 1a, whereby a capsular tension ring is shown, adapted to be implanted. The sizes in the

claim limitations majority use the term "about", whereby broadly interpreted, further where the device by Nagai is inherently sized appropriately to meet the application (e.g. where it is being implanted, human vs animal, etc.). Further, Nagai discloses use of a rigid material, such as PMMA **P56**. The eyelet or hole in the ring present as seen from the figures.

FIG. 1(a)

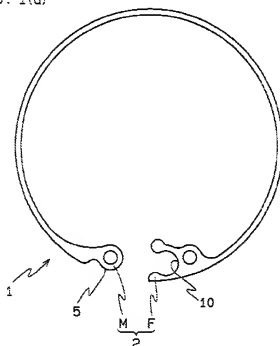


Figure 1(a) of Nagai

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 27-52 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagai US 2001/0004708.

With respect to the claims; as discussed supra, further with elaboration to the sizes of the implant. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the device to fit that of the subject. Furthermore, it is well within the technical skill in the art to make the implant sized and shaped to fit the subject, where it may be desirable.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. BOOTH whose telephone number is (571) 270-7027. The examiner can normally be reached on Monday thru Thursday 9:00am - 7:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Booth/

Application/Control Number: 10/541,673

Page 7

Art Unit: 3774

Examiner, Art Unit 3774

March 11, 2010

/Thomas J Sweet/

Primary Examiner, Art Unit 3774